

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application of:

Yukitaka SHIMIZU et al.

Application No.: 10/565,853

Confirmation No.: 8106

Filed: January 26, 2006

Art Unit: 3685

For: ACCOUNTING SYSTEM CONTENT
REPRODUCTION DEVICE, LICENSE
SALES DEVICE, PROGRAM AND
RECORDING MEDIUM

Examiner: K. Muhammad

PETITION UNDER 37 C.F.R. § 1.181(a)(3)

MS AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicant hereby petitions to invoke the supervisory authority of the Director in the above-identified application to have the Office Action dated March 4, 2010 withdrawn and to have this application transferred to a new Examiner for the reasons discussed in detail below. The supervisory authority of the Director is further sought in order to insure that any new Office Action replacing the Action dated March 4, 2010, is a non-final Action that sets forth a proper restriction requirement based upon unity of invention and that satisfies the completeness requirement of 37 C.F.R. § 1.104(c)(2), the requirement to answer the substance of applicant's arguments in MPEP § 707.07(f), and the requirement in MPEP § 707.07(d) as to rejection contents.

STATEMENT OF THE FACTS

On July 28, 2008, a Restriction Requirement was mailed that incorrectly applied the criteria of distinctness from MPEP § 800 instead of applying the "unity of invention" criteria of MPEP § 1893.03(d) and MPEP § 1850 that was required as to this application filed in accordance with 35 U.S.C. § 371 (entered the national stage from an international application). A Reply to this improper Restriction Requirement was filed on August 27, 2008, that pointed out the error in relying on the criteria of distinctness from MPEP § 800 instead of applying the "unity of invention" criteria of MPEP § 1893.03(d) and MPEP § 1850 and electing, with traverse, Group I, Claims 14, 16, 17, 20-23, 26, 27, 29, and 30 for prosecution.

The Examiner assigned to this above-noted application then transmitted the non-final Office Action dated December 24, 2008 to applicant. This initial non-final Action (dated December 24, 2008) was noted to be clearly improper in many respects in the first response under 37 C.F.R. § 1.111 that was filed March 24, 2009.

One such improper aspect of the above-noted initial non-final Office Action was noted to be the failure thereof to indicate any reconsideration of the Restriction Requirement mailed July 28, 2008, based upon the traverse of this requirement included with the response filed August 27, 2008. This first response further noted 37 CFR §1.143 had been violated by not repeating the traversed requirement and in not making the traversed Requirement final. This last point was noted to be important as it impacted on the right of the applicant to file a petition for review of the Requirement under 37 CFR §1.144.

A second improper aspect of this December 24, 2008 initial Office Action that was noted in the first response was that the rejection therein of pending claims 14, 16, 20, 22, and 23 under the second paragraph of 35 U.S.C. §112 was improper for a variety of reasons. In this regard, the lack of any explanation or examples in the December 24, 2008 initial Office Action was noted as were the provisions of MPEP §§ 2173.01 and 2173.02 that permitted the use of functional language.

Further in this last regard, the clear error in characterizing the functional language of claims 14, 16, 20, 22, and 23 as being process steps like those in exemplary claim 2 in the relied upon decision of *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990) was specifically noted.

The points as to improprieties raised in the March 24, 2009 first response notwithstanding, the PTO issued a first final Office Action on August 6, 2009. This first final Office Action was noted to be clearly improper at least as to the repeated Restriction Requirement in the second response filed September 30, 2009, as well as in the Petition under 37 C.F.R. § 1.144 that was simultaneously filed. In addition, the second September 30, 2009 response noted the improper nature of the repetition of rejections from the December 24, 2008 first Office Action with no attempt having been made to answer the substance of any of the arguments filed with the March 24, 2009 first response. On October 29, 2009, an Advisory Action was mailed that indicated that the second response filed September 30, 2009, would be entered without any indication of the status of the Petition filed September 30, 2009 or any proper consideration of the improper Restriction Requirement and the failure to answer the substance of the repeated arguments as noted above.

After repeated telephone calls to the Examiner and his Supervisor, Applicant's representatives were informed that the improper nature of the restriction requirement had been reconsidered in light of the Petition, and that the outstanding final Office Action of August 6, 2009 and the Restriction Requirement therein would be withdrawn and that a replacement Action including a restriction requirement based upon "unity of invention" would be forthcoming with the Petition being then treated as moot.

This first replacement Office Action (dated February 3, 2010) was received but was noted to be clearly improper in many respects. For example, the first replacement Action had been improperly made final even though it added new grounds of rejection as to claims 14, 16, 17, 20-23, 26, 27, 29, and 30 under 35 U.S.C. § 101 that was clearly not necessitated by any claim amendment. This first replacement Action further completely failed to address the arguments raised in the Amendments filed September 30, 2009 and March 24, 2009. A further deficiency was noted as to claims 34 and 35 (that had been added to replace claims 26 and 27 by the Amendment filed on March 2009) that were only noted in item 6 of the "Office Action Summary" sheet as being rejected without any specific rejection being made in the body of the first replacement Action.

Accordingly, a further telephone call was placed to point out errors in the first replacement Action of February 3, 2010, and this first replacement Action was withdrawn and

replaced by the present outstanding final Action dated March 4, 2010. While this present outstanding final Action does at least remove the improper rejection of claims 14, 16, 17, 20-23, 26, 27, 29, and 30 under 35 U.S.C. § 101, it corrects none of the other clear Action errors noted above.

This present outstanding final Action dated March 4, 2010, still violates the completeness requirement of 37 C.F.R. § 1.104(c)(2), it violates the requirement to answer the substance of applicant's arguments in MPEP § 707.07(f), and it violates the MPEP § 707.07(d) requirements as to rejection contents. This present outstanding final Action dated March 4, 2010, also fails to adequately consider that independent claims 14 and 16 of Group I include far more in common with independent claim 15 of Group II and independent claim 18 of Group III than just "applying license to devices that provide content." For example, each of independent claims 14-16 and 18 requires an "accounting server" to receive at least "content ID" and "accounting ID" to perform an accounting and to return an indication of a successful accounting after subtracting an appropriate amount from stored money information.

Item 6 of the Office Action Summary (the PTOL-326 attached to the present outstanding final Action) indicates that claims 34 and 35 are "rejected" but this statement fails to meet the requirements of 37 C.F.R. § 1.104(c)(2). Furthermore, the body of the outstanding Action does not set forth any specific rejection of claims 34 and 35. Not only does this violate 37 C.F.R. § 1.104(c)(2), it also violates MPEP § 707.07(d).

Further lacking from the present outstanding final Action of March 4, 2010, is any attempt to comply with MPEP § 707.07(f) that notes that when "the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it" (emphasis added). For example, the present rejection of claims 14, 16, 20, 22, 23, and 26 (a canceled claim) under the second paragraph of 35 U.S.C. § 112 repeats this rejection and the rationales offered in paragraphs 7-13 of the Office Action dated December 24, 2008, as paragraphs 12-19 of the present outstanding final Action. However, the clearly defective reasoning in repeated paragraphs 7-13 of the Office Action dated December 24, 2008 was previously traversed in the Amendment filed March 24, 2009 and the amendment filed September 30, 2009, which traversals continue to be unanswered.

REQUEST FOR RELIEF

In view of the above statement of facts and the failures of the present outstanding final Action of March 4, 2010, to address or correct the above noted inadequacies, Applicant respectfully requests that the Director exercise his supervisory authority to provide relief by at least requiring that the present outstanding final Action of March 4, 2010, be withdrawn and that all of the above-noted inadequacies are corrected in any subsequent Action. Furthermore, in light of the protracted improper prosecution and attendant unnecessary costs and delays that have arisen during the prosecution of this application, transfer of this application to a new Examiner is also requested.

In addition, if this Application is not transferred to a new Examiner, Applicant respectfully requests that the Director exercise his supervisory authority to instruct the SPE of Art Unit 3685 to still fully comply with MPEP § 707.02 and carefully study any subsequent Office Actions to insure that they properly present any unity of invention requirement. In addition, it is requested that the SPE be directed to carefully review any subsequent Actions for completeness under 37 C.F.R. § 1.104(c)(2) as well as to insure that the substance of applicant's arguments is answered as required by MPEP § 707.07(f) and that the requirements of MPEP § 707.07(d) as to rejection contents are followed.

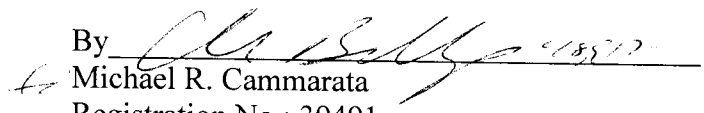
CONCLUSION

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: June 3, 2010

Respectfully submitted,

By



Michael R. Cammarata

Registration No.: 39491

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, VA 22040-0747

703-205-8000